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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/828,127 | 04/09/2001 | Stefano Faccin | 017.38447PX2 | 5967 |

20457 7590 03/03/2004

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EXAMINER

CHO, UN C

ART UNIT PAPER NUMBER

2682

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,127

Applicant(s)

FACCIN ET AL.

Examiner

Un C Cho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3 - 12 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/9/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6 and 7</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 7/15/02 and 8/28/03 was filed after the mailing date of the 04/09/2001 on application 09/828127. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Regarding claim 7, claimed subject matter of "the second network is an IMS network" in line 1 – 2 is not adequately disclosed in the specification. There is not any specific disclosure in the specification related to IMS network.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 recites the limitation "the second network" in line 1 of the claim.

Claim 9 recites the limitation "the second network element" in line 1 of the claim.

Claim 10 recites the limitation "the third network element" in line 1 of the claim.

Claim 11 recites the limitation "the fourth network element" in line 1 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 6, 8, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kannas et al. (US 6,683,853).

Regarding claim 1, Kannas teaches a user station initiating a packet data communication session by requesting a certain quality of service to the telecommunication network (Col. 2, lines 11 – 16) and indicating to the core network (Fig. 1, 6) whether the user station accepts or declines the quality of service offered by the network (Col. 2, lines 36 – 42).

Regarding claim 4, Kannas teaches setting up a communication session between the user station and one of the elements (Fig. 1, 20) of the core network (Fig. 1, 6) (Col. 3, lines 52 – 60).

Regarding claim 6, Kannas teaches a core network (Fig. 1, 6) as one of network the elements of the telecommunication network.

Regarding claim 8, Kannas teaches a SGSN (Fig. 1, 20) as one of the network elements of the telecommunication network.

Regarding claim 9, Kannas teaches a RNC (Fig. 1, 18) as one of the network elements of the radio network system (Fig. 1, 16).

Regarding claim 11, Kannas teaches a GGSN (Fig. 1, 24) as one of the network elements of the telecommunication system.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3/1, 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kannas in view of Barany et al. (US 2002/0034166).

Regarding claim 3/1, Kannas teaches setting up communication session between the user station and the telecommunication network and allocating radio resources for the communication channel (Col. 2, lines 11 – 16). However,

Kannas fails to teach setting up communication channel without radio resources setting up a communication session between the user equipment and third network element in a second network. In contrast, Barany teaches a call control signal communicated through the access network is forwarded by the GGSN to the CSCF module and a call session is established after a call setup procedure is performed (Barany, Paragraph 0037, lines 1 - 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Barany to Sexton to enable voice and other forms of real-time or streaming communications over packet-switched wireless networks.

Regarding claim 5, Kannas fails to teach indicating to a fourth network element in the first network that radio resources are not allocated for the communication channel before a communication session has been successfully established. However, Barany teaches a call control signal communicated through the access network is forwarded by the GGSN and a call session is established after a call setup procedure is performed (Barany, Paragraph 0037, lines 1 - 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Barany to Sexton to enable voice and other forms of real-time or streaming communications over packet-switched wireless networks.

Regarding claim 10, Kannas fails to teach the third network element is a CSCF. However, Barany teaches CSCF as being one of the elements (Fig. 1, 41). Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the teaching of Barany to Sexton to enable voice and other forms of real-time or streaming communications over packet-switched wireless networks.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kannas in view of Wang (US 2002/0131395).

Regarding claim 7, Kannas fails to teach the second network is an IMS network. However, Wang teaches an IMS network (Paragraph 0077). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wang to Kannas to provide the high data rate making it possible for a mobile user to access to data and multimedia content.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kannas in view of Hauris et al. (US 5,422,883).

Regarding claim 12, Kannas fails to teach determining by a user equipment to set up a communication session with multiple components. However, Kannas teaches setting up communication channel between the user station and a SGSN of the core network and setting up a communication session between the user station and the Radio Network Controller (Kannas, Col. 3, lines 50 – 62). In contrast, Hauris teaches determining by the sender (initiator of the conference) to establish the communication pathway (Call Setup) among various participants (Hauris, Col. 2, lines 51 – 57). Therefore, it would have been obvious to one of ordinary skill in the art at the

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time the invention was made to provide the teaching of Hauris to Kannas to create a method to establish a multi-party, multi-media conference call.

Allowable Subject Matter

12. Claims 2 and 3/2 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

Regarding claim 2, Kannas (US 6,683,853) teaches forwarding and receiving the message in the Radio Network Controller. However, Kannas fail to teach second network element refraining to allocate radio resources for the communication channel.

Conclusion

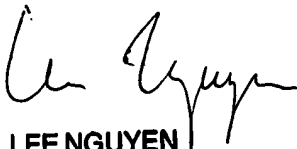
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C Cho whose telephone number is (703)305-8725. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703)308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Un C Cho UC
Examiner
Art Unit 2682
3/2/2004


LEE NGUYEN
PRIMARY EXAMINER